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AMENDMENT UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 1642
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Tohru TANAKA, et al.

Appln. No.: 09/445,963

Confirmation No.: 1604

Filed: December 16, 1999

For: AGENT FOR DIAGNOSING AND TREATING MALIGNANT TUMORS

SECOND SUPPLEMENT TO AMENDMENT UNDER 37 C.F.R. § 1.116

ATTN: BOX AF

Commissioner for Patents

Washington, D.C. 20231

Sir:

Further to Applicants' SUPPLEMENT TO AMENDMENT ... WITH
ENGLISH TRANSLATION filed March 28, 2002, applicants would like to offer the
following remarks on the rejection of claims 8 and 9 as obvious over Jichlinski and
Jaffe.

Obviousness Rejection over Jichlinski in view of Jaffe

The present invention and Jichlinski both involve the fact that ALA
accumulates to a malignant tumor.

However, neither Jichlinski nor Jaffe disclose nor suggest that the malignant
tumor can be diagnosed with NMR such as MRI or the like by using ALA of a

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Examiner: N. Davis

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specific isotope or derivative form as claimed herein. Accordingly, it is not believed that one of ordinary skill in the art would be led to the present invention as claimed from the teaching of Jichlinski and Jaffe.

In the field of structural analyses and metabolic studies, conventional compounds are structurally analyzed with NMR by introducing a stable isotope into the compounds as a general technique (e.g., Kajiwara, Jaffe).

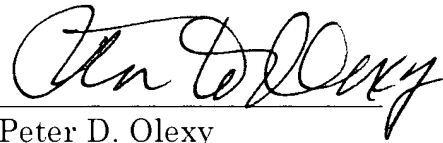
However, in such techniques, the reactant must be separated and purified and the compound to be examined must be subjected to NMR spectral measurement. Even if techniques from the field of structural analysis and metabolic studies are combined with Jichlinski (disclosing that porphyrins accumulate to a tumor in the administration of ALA), one of ordinary skill in the art would not find obvious application to detection or diagnosis in the sense of the present invention.

The present invention and Jichlinski both also relate to treatment of malignant tumors. However, in the present invention, the position of the malignant tumor can be more easily identified using NMR such as MRI or the like as compared to Jichlinski. Therefore, a more effective treatment is obtained by a combination with laser treatment or the like in accordance with the present invention.

Second Supplement to Amendment Under 37 C.F.R. § 1.116
U.S. Appln. No. 09/445,963

The Examiner is respectfully requested to reconsider the rejection of claims 8 and 9 as obvious over Jichlinski in view of Jaffe.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Peter D. Olexy", written over a horizontal line.

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